

### **REMARKS**

Because October 1, 2006, three months after the mailing date of the Office Action, falls on a Sunday, the period for response is extended to October 2, 2006, which is the next day that is neither a Saturday, Sunday nor a Federal holiday in the District of Columbia.

Reexamination in light of the following remarks is respectfully requested.

Claims 1-3, 16-18, 21-22, 24-26, 28-30, and 33-34 are currently present in the above-identified application, with claims 1, 16, 17, 24 and 29 being independent.

#### **Claim objection**

Paragraph 4 of the Office Action indicates an objection to claim 16.

This objection is traversed at least for the following reasons.

While not conceding the propriety of this objection and in order to advance the prosecution of the above-identified application, claim 16 has been canceled.

Withdrawal of this objection is respectfully requested.

#### **Double patenting rejection**

Paragraph 6 of the Office Action indicates that claims 1-3, 16-18, 21-22, 24-26, 28-30, 33 and 34 have been rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 2, 3, and 8 of co-pending Application No. 09/748,188.

Paragraph 7 of the Office Action indicates that claims 1-3, 16-18, 21-22, 24-26, 28-30, 33 and 34 have been rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1-11 and 13-18 of U.S. Patent No. 6,605,341.

Paragraph 8 of the Office Action indicates that claims 1-3, 16-18, 21-22, 24-26, 28-30, 33 and 34 have been rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1-3, 16-19, 22, 24-26, 28-30 and 33-34 of U.S. Patent No. 6,617,018.

These rejections are traversed at least for the following reasons.

Paragraph 6 of the Office Action highlights the presence of co-pending Application No. 09/748,188. The Office Action concludes that the claims found within the present application and the co-pending application are not identical (Office Action at page 3).

Paragraph 7 of the Office Action highlights the presence of U.S. Patent No. 6,605,341. The Office Action additionally concludes that the claims found within the present application and those found within U.S. Patent No. 6,605,341 are not identical (Office Action at page 4).

Paragraph 8 of the Office Action highlights the presence of U.S. Patent No. 6,605,341. The Office Action concludes that the claims found within the present application and those found within U.S. Patent No. 6,617,018 are not identical (Office Action at page 4).

Instead, the Office Action asserts, *without providing any supporting evidence*, that the differences between the claims found within the present application and those found within the co-pending application, within U.S. Patent No. 6,605,341, and within U.S. Patent No. 6,617,018 would have been obvious to the skilled artisan (Office Action at pages 3-4).

In response, the teachings, suggestions or incentives supporting the obviousness-type rejection must be clear and particular. Broad conclusory statements, standing alone, are not evidence. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). However, this contention is merely a personal conclusion that is unsupported by any objective evidence.

As a rule, "assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the

appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference.” (Citations omitted). *In re Pardo and Landau*, 214 USPQ 673, 677 (CCPA 1982). The support must have existed at the time the claimed invention was made. *In re Merck & Co., Inc.*, 231 USPQ 375, 379 (Fed. Cir. 1986).

“Allegations concerning specific ‘knowledge’ of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge.” (Citations omitted). *In re Pardo and Landau*, 214 USPQ 673, 677 (CCPA 1982).

In addition, “it is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the applicant's combination would have been obvious” (citations omitted). *In re Gorman*, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). See also *In re Dembiczak*, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999) (rejection based upon hindsight is reversed).

Moreover, the procedures established by Title 37 of the Code of Federal Regulations expressly entitle the Applicant to an Examiner's affidavit upon request. Specifically, “when a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.” 37 C.F.R. §1.104(d) (2).

*Accordingly, Applicant hereby requests a reference or an Examiner's affidavit to support this officially noticed position of obviousness or what is well known.*

*Further, note that if this reference or Examiner's affidavit is not provided, the assertions of what is well known **must** be withdrawn. See M.P.E.P. §2144.03.*

Also, note that the failure to provide any objective evidence to support the challenged use of Official Notice constitutes clear and reversible error. *Ex parte Natale*, 11 USPQ2d 1222, 1227-1228 (Bd. Pat. App. & Int. 1989).

In addition, this assertion amounts to nothing more than an "obvious-to-try" situation. Specifically, "an 'obvious-to-try' situation exists when a general disclosure may pique the scientist's curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued." *In re Eli Lilly & Co.*, 14 USPQ2d 1741, 1743 (Fed. Cir. 1990). Moreover, "an invention is 'obvious to try' where the prior art gives either no indication of which parameters are critical or no direction as to which of many possible choices is likely to be successful." *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 10 USPQ2d 1843, 1845 (Fed. Cir. 1989).

Here, the cited prior art does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued. "Obvious to try" is not the standard under §103. *In re O'Farrell*, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988).

Withdrawal of these rejections and allowance of the claims is respectfully requested.

### **Conclusion**

For the foregoing reasons, all the claims now pending in the present application are allowable, and the present application is in condition for allowance. Accordingly, favorable reexamination and reconsideration of the application in light of the amendments and remarks is courteously solicited.

If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone Brian K. Dutton, Reg. No. 47,255, at 202-955-8753.

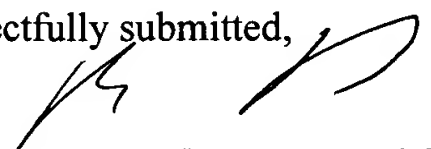
Application No. 09/747,955  
Amendment dated October 2, 2006  
Reply to Office Action of June 1, 2006

Docket No.: OKA-0020

If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Dated: October 2, 2006

Respectfully submitted,

By   
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